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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,340	04/20/2001	Kanji Nakamura	Q64219	1059

7590 06/30/2003  
SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

BRAY, WAYMOND D

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

# Office Action Summary

Application No.

09/838,340

Applicant(s)

Nakamura, et al

Examiner

W. Donald Bray

Art Unit

3725



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-43 is/are pending in the application.
- 4a) Of the above, claim(s) 34 and 36-43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8, 11, 12, 15-25, and 33 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 13, 14, and 26-32 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 1/2 6) ☐ Other:

## **DETAILED ACTION**

This action replaces that mailed 03-17-03.

### **Housekeeping**

As a matter of housekeeping, it should be noted that there was no claim numbered 36 originally filed in this application. Accordingly, claims numbered 37-44 have been renumbered 36-43. And as claim 35 has been cancelled by amendment, the claims presently before the examiner are 1-34 and 36-43.

### **Priority**

1. Acknowledgement is made of applicant's claim for priority under 35 USC 119.

The certified copies have been received and placed of record in the file.

### **Information Disclosure Statement**

2. Receipt is hereby acknowledged on an Information Disclosure Statement (I.D.S.) dated November 14, 2002. The I.D.S. has been placed of record in the file, and a dated, signed, and initialed copy of the same is included with this action.

### Treatment of Claims

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8, 12, 15, 24, 25 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bendzick.

6. Bendzick shows the invention as claimed including primary and secondary press units (17,14), which compress metal shavings (sludge) containing oil (herein read as the claimed coolant).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11, 16 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendzick in view of Eliot.

Bendzick shows the combination substantially as claimed as outlined herein above. Bendzick fails to include means for heating, and the specific composition of the chips. However, applying heat to oil based sludge comprising chips for purposes of making briquettes is old and well-known as evidenced by the patent to Eliot, for purposes of ease of formation of metal chips, it would have been obvious to include heating means in Bendzick as taught by Eliot- no new nor unobvious results flowing therefrom.

The type of heater and the range of heat utilized are considered to be matters of obvious mechanical choice of design.

9. Claims 9, 10, 13, 14 and 26-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 34 and 36-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

11. Claims 1-7 are allowed.

Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to W. Donald Bray whose telephone number is (703) 308-1871. The examiner can normally be reached on Monday through Friday from 8:30 Am to 3:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Ostrager, can be reached on (703) 308-3136. The fax phone number for this Group is (703) 305-3579.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging faxing of responses to Office actions directly into the Group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be

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used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Bray of Art Unit 3725 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Bray/DL

June 23, 2003

*W. D. Bray*  
W. DONALD BRAY  
PRIMARY EXAMINER